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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,049	06/27/2003	Kenichi Hiraoka	239516US0CONT	4138
22850	7590	03/07/2005		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KUHN, SARAH LOUISE	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,049

Applicant(s)

HIRAOKA ET AL.

Examiner

Sarah L Kuhns

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Yip, U.S. Patent 3,852,489. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

In regard to claims 12 and 14-18, Yip discloses a fresh fish egg product made from treatment with the aqueous alkali solution (column 2, line 36).

In regard to claim 13, Yip discloses a fresh fish egg product wherein the fish eggs are from salmon (column 2, line 36).

In regard to claims 19 and 20, Yip discloses a fish product that is salted hard roe of salmon (column 2, line 27).

Claim Rejections - 35 USC § 103

Claims 1, 2, and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yip, U.S. Patent 3,852,489, in view of Bender, U.S. Patent 5,262,186 and Bedford, U.S. Patent 2,280,024.

In regard to claim 1, Yip discloses a process for producing a fresh fish egg product comprising treating roe with an aqueous alkali solution (column 2, line 50). Yip discloses dissolving an alkali in water to produce the aqueous alkali solution (column 4, line 14). Yip further discloses the use of alkali metal sulfites and citrates (column 3, line 17) and also teaches that other water soluble compounds can be used as well (column 3, line 15). Yip fails to disclose the washing off or neutralizing of the roe. Bender, however, discloses a process for treating fish with an aqueous alkali solution (column 4, line 46) and additionally discloses that the fish can be washed with and/or neutralized with acid following the alkali treatment (column 5, line 45). It would therefore be obvious to wash and/or neutralize the roe to remove the aqueous alkali solution after treatment is complete.

Yip fails to disclose the use of the specific alkalis claimed by applicant. Bedford discloses the use of dry alkalis, such as sodium carbonate, potassium carbonate (column 2, lines 13-17), sodium hydroxide, potassium hydroxides, and alkali salts (column 3, lines 18-25), in the preservation of fish viscera. It would therefore have been obvious to use an alkali known to be an effective preserving agent, as taught by Bedford, in the aqueous alkali

Art Unit: 1761

solution of Yip, because the use of an alkali solution, instead of a dry alkali, would allow for more uniform exposure of the roe to the preserving agent.

In regard to claim 2, Yip discloses roe from salmon (column 2, line 28).

In regard to claims 5-7, Yip fails to disclose the exact pH of the aqueous alkaline treatment solution. Bender discloses a preferred pH range of 11.6-13.5 (column 4, line 63) and Bedford teaches a pH in excess of 9.0 (column 2, lines 38-43). It would therefore be obvious to use such a pH for the alkali solution in order to ensure that all bacteria present is killed or at least greatly reduced.

In regard to claim 8, Yip discloses a treatment time of about 20 minutes (column 4, line 21).

In regard to claim 9, Yip discloses a treatment temperature of 50-60°F, which is 10-15.6°C (column 4, line 19).

In regard to claim 10, Yip fails to disclose the washing time of the fish product. However, Bender discloses that the fish can be washed with and/or neutralized with acid following the alkali treatment (column 5, line 45). Although Bender does not disclose an exact washing time it would be obvious to wash the fish product until the remaining alkali solution was completely removed. One skilled in the art would have determined the amount of time sufficient to remove the alkali solution by routine experimentation.

In regard to claim 11, Yip fails to disclose the washing of the fish product. Bender discloses washing the fish product with water (column 5, line 46). It would be obvious to wash the fish product with water because water is readily available and will successfully remove or at least dilute the alkali solution remaining on the fish product.

Response to Arguments

Applicant's arguments filed January 18th, 2005 have been fully considered but they are not persuasive.

Applicant first argues that Yip fails to disclose or suggest the washing off or neutralized of the aqueous alkali solution on the treated fish egg(s) or milt. However, as stated above, Bender discloses a process for treating fish with an aqueous alkali solution (column 4, line 46) and additionally discloses that the fish can be washed with and/or neutralized with acid following the alkali treatment (column 5, line 45). It would therefore have been obvious to wash and/or neutralize the roe to remove the aqueous alkali solution after treatment is complete. Applicant argues that Bender discloses the fish being treated after they are eviscerated, but in fact Bender teaches that the treatment solution is "applicable to any fish or shellfish from salt or freshwater either in whole, eviscerated, or filleted condition" (column 4, lines 65-66). Since the treatment of Bender is applicable to whole fish it would follow that it is effective on all parts of the fish including the viscera.

Applicant next argues that neither Yip nor Bender suggest the use of the specifically claimed alkali solution. This argument has been considered but is moot in view of the new ground(s) of rejection.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah L. Kuhns whose telephone number is 571-272-1088. The examiner can normally be reached on Monday - Friday from 8:00 am - 4:30 pm.

Art Unit: 1761

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLK


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